

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner rejected claims 1-4, 8, 9, 12-15, 19-22, and 25-34<sup>2</sup> under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,697,865 to Howard et al. ("*Howard*"); and rejected claims 5-7, 10, 11, 16-18, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Howard* in view of U.S. Patent Application Publication No. 2002/0138331 to Hosea et al. ("*Hosea*").

Claims 1-34 remain pending in this application.

**I. Information Disclosure Statements filed March 20, 2008 and April 8, 2008**

On page 2 of the Office Action, the Examiner states: "[a]pplicant has submitted 46 patent[] documents for review. Due to the large number of documents, the Examiner has made a *cursory review* of this collection and requests that the Applicant cite passages relevant to the examination of the filed claims" (emphasis in original). Applicant respectfully asserts that a cursory review is improper. As acknowledged by the Examiner, the M.P.E.P does not require citation of "passages relevant to the examination of the filed claims." Instead M.P.E.P § 609.04(a) states:

[a]n information disclosure statement filed in accordance with the provisions of 37 CFR 1.97 and 37 CFR 1.98 **will be considered by the examiner** assigned to the application. Individuals associated in a substantive way with the filing and prosecution of a patent application are **encouraged** to submit information to the Office so the examiner can evaluate its relevance to the claimed invention . . . . Once

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

<sup>2</sup> Page 3 of the Office Action only sets forth the rejection of claims 1-4, 8, 9, 12-15, 19-22, 25, and 26 under 35 U.S.C. § 102(e). Claims 27-34, however, also appear to be rejected under 35 U.S.C. § 102(e). Office Action, pages 7 and 8. In view of this discrepancy, Applicant assumes that claims 1-4, 8, 9, 12-15, 19-22, and 25-34 are rejected under 35 U.S.C. § 102(e) and requests clarification from the Examiner if the assumption is incorrect.

the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met, **the examiner has an obligation to consider the information.** There is no requirement that the information must be prior art references in order to be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means nothing more than considering the documents in the **same manner as other documents in Office search files** are considered by the examiner while conducting a search of the prior art in a proper field of search. **The initials of the examiner placed adjacent to the citations on the \*\* PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above . . . .** Multiple information disclosure statements may be filed in a single application, and **they will be considered,** provided each is in compliance with the appropriate requirements of 37 CFR 1.97 and 37 CFR 1.98. (Emphasis added)

Applicant has met all requirements for submitting these documents, particularly since all documents are U.S. patents or English language documents. Therefore the Examiner has an obligation to consider the information in the same manner as other documents in office search files. Since, the initials of the Examiner have been placed adjacent to the citations on the PTO/SB/08 forms, Applicant asserts that the record should denote that the information has been considered by the examiner in the same manner as other documents in Office search files.

Accordingly, in view of the foregoing, Applicant respectfully requests the Examiner to reconsider the listed documents and acknowledge that the cited documents are considered in the same manner as other documents in Office search files, as required by the M.P.E.P.

## **II. Previous Rejections under 35 U.S.C. §101**

Pages 2 and 3 of the Office Action state that "the 'machine-readable storage

medium' (preambles of claim 25 and 26) is understood to be comprised of these cited examples and not to be additionally or alternatively comprised of a 'machine-readable signal'." Applicant clarifies that claims 25 and 26 recite statutory subject matter as they are directed to a "machine-readable storage medium including machine-readable instruction," as authorized by the guidelines provided in the M.P.E.P. See M.P.E.P. § 2106.01.

**III. Rejection of Claims 1-4, 8, 9, 12-15, 19-22, and 25-34 under 35 U.S.C. § 102(e)**

Applicant respectfully traverses the rejections of claims 1-4, 8-9, 12-15, 19-22, and 25-26 under 35 U.S.C. § 102(e) as being anticipated by *Howard*. In order to properly establish that *Howard* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 recites a method including, among other steps "identifying one or more entities related to the user, said one or more entities having corresponding entity profiles including context information comprising a plurality of types of categorized data" and "**importing** at least the portion of the context information into the user profile, wherein the imported portion **comprises data selected from the plurality of types of categorized data**" (emphasis added). *Howard* does not disclose or even suggest at least these features of claim 1.

*Howard* discloses:

company profile can include demographic data; lists of other companies with which the company has a relationship; in some implementations a list of the maximum permissions that users at the company **can be given** in creating or managing the profiles of other users and companies . . . . A user profile may include demographic data; **permissions given to the user** to create and manage the profiles of other users and companies; a list of permissions **given to the user** with respect to other objects in the system; a list of preferences of the user for his personal relationship portal; and a list of other users who are allowed to manage the profile of the user. (Emphasis added, col. 4, lines 30-41).

[A] permission (the "perform permission") gives a user the right to perform a specific function offered by a portal application. As suggested in the example shown in FIG. 2, the grant right of a permission (the "grant permission") gives a user the right to grant to other users the perform permission and the grant permission with respect to the application functionality associated with the permission. The grant and perform permissions are **represented by flags in the profiles stored** in the portal management database. As shown in FIG. 2, user A's grant permission 100 **enables** user A to grant perform permission 102 to user B. (Emphasis added, col. 7, lines 43-53).

Thus, in *Howard*, user profiles are **given** permissions based on the permissions assigned to the user's company. As noted above, these permissions are given by enabling flags in user profiles. Such a disclosure, however, does not teach or even suggest "**importing** at least the portion of the context information into the user profile, wherein the imported portion comprises data selected from the plurality of types of categorized data," (emphasis added) as recited in claim 1. This is because enabling flags in a profile does not constitute importing at least the portion of the context information into the user profile. *Howard* merely gives permissions by enabling flags

based on flags in a company profile and is silent with respect to importing context information into user profiles.

Moreover, even if enabling flags in a user profile could constitute the claimed “importing” and the demographic data, and permissions and preferences of *Howard* could constitute the claimed “plurality of types of categorized data,” *Howard* still does not teach or even suggest the claimed user profile where an imported portion of the context information in the “user profile **comprises data selected from the plurality of types of categorized data,**” as further recited in claim 1. This is because the permissions of *Howard* only constitute one type of data and permission.

The Examiner alleges that the “permissions” of *Howard* constitutes Applicant’s claimed “context information.” (Office Action, page 9). As noted above, the permissions of *Howard* cannot constitute the claimed “imported portion of the context information” because the permissions of *Howard* does not **comprise** data selected from the **plurality of types of categorized data**. The permission in *Howard* is just one type of data and not a “plurality of types of categorized data,” as recited in claim 1. Therefore, *Howard* does not teach or even suggest “identifying one or more entities related to the user, said one or more entities having corresponding entity profiles including context information comprising a plurality of types of categorized data” and “**importing** at least the portion of the context information into the user profile, wherein the imported portion **comprises data selected from the plurality of types of categorized data,**” (emphasis added) as recited in independent claim 1.

Accordingly, for at least these reasons *Howard* cannot anticipate claim 1 and the rejection of claim 1 should be withdrawn.

Independent claims 14, 25, and 26 while of different scope, recite features similar to those of claim 1 and are thus allowable over *Howard* for at least similar reasons to those discussed above for claim 1. Claims 2-4, 8, 9, 12, 13, 15, 19-22, and 27-34 are also allowable at least due to their dependence from one of the independent claims.

Accordingly, for at least the reasons noted above, the rejection under 35 U.S.C. § 102(e) is improper and should be withdrawn.

**IV. Rejection of Claims 5-7, 10, 11, 16-18, 23, and 24 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 5-7, 10, 11, 16-18, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Howard* in view of *Hosea*, because a *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." *M.P.E.P. § 2145*. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. *M.P.E.P. § 2143.01(III), internal citation omitted*. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole

would have been obvious." *M.P.E.P.* § 2141.02(I), internal citations omitted (emphasis in original).

Claims 5-7, 10, 11, 16-18, 23, and 24 depend from one of independent claims 1 or 14, and thus include all features of claims 1 or 14. *Hosea* fails to remedy the above-noted deficiencies of *Howard* with respect to independent claims 1 and 14.

Consequently, any proper combination of *Howard* and *Hosea* does not present a *prima facie* case of obviousness with respect to claims 1 and 14, and therefore dependent claims 5-7, 10, 11, 16-18, 23, and 24 are allowable.

Accordingly, for at least the above-noted reasons, reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection is respectfully requested.

#### CONCLUSION

In view of the foregoing, Applicant requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: November 26, 2008

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